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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,650	09/11/2002	Klaus Peter Maass	215849	3547

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EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,650

Applicant(s)

MAASS, KLAUS PETER

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Priority

Receipt of application 9920394.5 is acknowledged.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the lip of the first side wall being cut through across its length producing two ends facing each other which are rejoined (claim 3), the distal edge portion of the second side wall being cut through at the corner and rejoined with a mitered joint having a miter angle corresponding to the predetermined angle of the corner (claims 9 and 15), an insert wall spacing apart the distal edge portion of the first side wall and the remainder of the first side wall and having a progressively increasing and decreasing size (claim 9), and the first and third side walls forming a channel for receiving the window glass (claim 11) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the lip of said first side wall where it is physically separated from that side wall along the region is cut through across its length and a lengthwise-extending portion of the lip of the first side wall removed at the first cut to reduce the length of the lip of the first side wall and to produce two ends facing each other across the first cut, the two facing ends then being re-joined. See claim 3. Additionally, the specification fails to provide proper antecedent basis for the insert wall being secured between and spacing apart the distal edge portion of the first side wall. Note that only the background of the invention refers to this structural arrangement.

Claim Rejections - 35 USC § 112

Claims 3-9 and 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "a third cut" on line 3 of claim 4 render the claims indefinite because the applicant has set forth three cuts in claim 15 for the first, second and third walls. Recitations such as "secured" on line 2 of claim 6 render the claims indefinite because it is unclear to what element of the invention the insert is secured. Recitations such as "position" on line 2 of claim 7 render the claims indefinite because it is unclear if the applicant is referring to the position set forth above or is attempting to set forth another position in addition to the one set forth above. Recitations such as "the lip" on line 10 of claim 9 render the claims indefinite because it is unclear to which one of the plurality of lips set forth above the applicant is referring. Recitations such as "the remainders . . . with the insert wall" on lines 39-41 of claim 9 render the claims indefinite because it is unclear the first, second and third side walls can be removed and replaced with an insert when one of the insert walls spaces apart the distal edge portion of the first side wall and the remainder of the first side wall (see lines 21-22 of claim 9). Recitations such as "first and third side wall . . . form a channel" on lines 1-2 of claim 11 render the claims indefinite because it is unclear how the first and third side walls can form a channel for receiving the window glass. See figure 3 wherein the third and second side walls form the channel for receiving the window glass. Recitations such as "first, second and third sidewalls" on line 2 of claim 12 render the claims indefinite

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because it is unclear if the applicant is referring to the sidewalls of the insert or the sidewalls of the channel arrangement. Recitations such as "the channel arrangement being bent" on line 7 of claim 15 render the claims indefinite because it is unclear how the base of the channel arrangement can be bent to match the corner when the base of the channel arrangement has been removed. Recitations such as "means of a second cut" on line 16 of claim 15 render the claims indefinite because the applicant has attempted to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding or following "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Recitations such as "said separated distal edge region . . . angle at the corner" on lines 17-20 of claim 15 render the claims indefinite because it is unclear what the applicant is attempting to set forth. What is the second side wall rejoined with?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, 8, 9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Publication 2 311 799 in view of Christian. UK Patent Publication 2 311 799 discloses in combination, a frame 12 defining a window opening

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(not numbered, but shown in figure 1) positioned between a first environment and a second environment and having a corner 16 and a window glass sealing and guiding channel arrangement 18 mounted on the frame, the channel arrangement comprising a channel base 22 and first 24 and second 26 integral channel side walls made of flexible material, each side wall having a distal edge portion (not numbered, but shown in figure 7) carrying a lip 28 and 30, respectively, extending along the side wall, the channel being bent to match the corner along a predetermined region (A) of the channel, the channel arrangement being mounted in the frame so that the first side wall is positioned in the first environment and the second side wall is positioned in the second environment, the distal edge portion including the lip of the first side wall being physically separated from the first side wall by a first cut which extends through the first side wall and along the region of the physically separated lip bridging across the corner, the distal edge portion including the lip of the second side wall being physically separated from the second side wall by a second cut which extends through the second side wall and along the region of the channel, the separated lip on the second sidewall having been cut through at an intermediate point along the region and re-joined with a miter joint matching the corner, the base of the channel and the parts of the side walls physically separated from the lips along the region forming a channel portion which is completely removed from the arrangement, a predetermined insert 47 being secured in position in the arrangement to replace the completely removed the channel portion, the insert comprising a base (not numbered, but shown in figure 8) and a first (not numbered, but comprising the longer of the two walls in figure 8) and a second (not numbered, but

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comprising the shorter of the two walls in figure 8) side walls which replace the base and the first and second side walls of the completely removed the channel portion but are sized to extend to and to be respectively secured to the physically separated lips, a lip 44 within the channel. UK Patent Publication 2 311 799 is silent concerning a third side wall.

However, Christian discloses a window sealing and guiding channel comprising a first side wall 24 having a lip 16 and a third side wall 42 having a lip 32, the third side wall 42 being sized and positioned to substantially overlie the first side wall 24 and thereby cover the insert from view through the window glass in the direction from a second environment outside the vehicle door to a first environment inside the vehicle.

It would have been obvious to one of ordinary skill in the art to provide UK Patent Publication 2 311 799 with a configuration, as taught by Christian, to more securely attach the window sealing and guiding channel to a vehicle and to better seal the window glass with respect to the window frame.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Publication 2 311 799 in view of Christian as applied to claims 3-6, 8, 9 and 11-15 above, and further in view of Kawai. Kawai discloses a window sealing and guiding channel 4 having an integrally molded insert 4D.

It would have been obvious to one of ordinary skill in the art to provide UK Patent Publication 2 311 799, as modified above, with an integrally molded insert, as taught by Kawai, to better seal the window within the sealing and guiding channel.

Response to Arguments

Applicant's arguments filed December 6, 2004 have been fully considered but they are not persuasive.

The applicant's comments concerning the third wall of Christian being integrally joined to the weatherstrip are not persuasive because they are not supported by the claim language. Note that nothing in the claims prevents the third wall being integrally joined to the weatherstrip.

With respect to the applicant's comments concerning the third wall covering the insert from view from a second environment to a first environment, the examiner respectfully disagrees. It appears that the applicant assumes that view from the second to the first environments is made generally perpendicular to the first side wall of the insert. This limitation, however, is not required by the claims. Therefore, one could have a view from the second to the first environment that is at an angle with respect to the first side wall of the insert. This view could be made from "below" the weatherstrip from a position near the end of the window glass that is adjacent the beltline of the door. From such an angle, the third side wall of Christian covers the first side wall of the insert. Accordingly, it is suggested that the applicant amend the claims so that the third side wall completely covers the first wall of the insert from view from the second to the first environment. Finally, the third side wall of Christian does not include a metal insert and therefore can be easily cut through.


Conclusion

THIS ACTION IS NOT MADE FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a long horizontal flourish extending to the right.

Gregory J. Strimbu
Primary Examiner
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December 27, 2004